

REMARKS

Claims 6-9 and 11-19 are pending in the present application. Claims 6, 11, 14 and 16 have been amended.

Information Disclosure Statement

Enclosed are copies of an Information Disclosure Statement and PTO/SB/08A Form filed on June 2, 2005. Also enclosed is a copy of a dated, stamped postcard receipt provided as evidence that the Information Disclosure Statement was received by the U.S. Patent Office. **The Examiner is respectfully requested to acknowledge receipt of the Information Disclosure Statement filed on June 2, 2005, and to confirm that the documents listed thereon have been considered and will be cited of record in the present application.**

Claim Rejections-35 U.S.C. 112

Claims 6-9 and 11-19 have been rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner has alleged that the written description fails to reasonably convey that the inventor had possession of the claimed invention "whereby edges of said protective layer are not covered by side walls". This rejection is respectfully traversed for the following reasons.

Claim 6 has been amended to feature "said protective layer being a conductive layer and having an edge thereof on said field oxide, whereby edges of said protective

layer are not covered by sidewall spacers". Although not necessarily limited thereto, these features may be interpreted as illustrated in Fig. 1(h) of the present application, wherein gate 35 is shown as having sidewall 37 thereon, and whereby polysilicon layer (protective layer) 12 is shown as not including a sidewall thereon. Applicant notes that side-walls 27 as illustrated in Fig. 1(h) are commonly understood and described in the art as sidewall spacers. Independent claims 11 and 16 have been amended in a somewhat similar manner as claim 6 noted above.

Manual of Patent Examining Procedure Section 2163 sets forth the principle that it is well accepted that a satisfactory description may be in the claims **or any other portion of the originally filed specification**. As the court held in Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Circ. 1997): "An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structure, figures, diagrams, and formulas that fully set forth the claimed invention."

Applicant respectfully submits that at least in view of Fig. 1(h), the original application reasonably conveys possession of the above noted features, whereby "edges of said protective layer are not covered by sidewall spacers". Claims 6-9 and 11-19 should thus be considered as in compliance with 35 U.S.C. 112, first paragraph. The Examiner is thus respectfully requested to withdraw this rejection for at least these reasons.

Claims 6-9 and 11-19 have been rejected under 35 U.S.C. 112, second

paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. The Examiner has alleged that the features “whereby edges of said protective layer are not covered by side walls” are negative limitations that render the claim indefinite because these features attempt to claim the invention by excluding what the inventor *did not invent*, rather than distinctly and particularly point out what was invented. The Examiner has further asserted that the above noted features contradict “an insulating layer, a contact hole, and a connecting wire formed above a surface of the substrate”, as also featured in claim 6. This rejection is respectfully traversed for the following reasons.

As noted above, claim 6 has been amended to feature “said protective layer being a conductive layer and having an edge thereof on said field oxide, whereby edges of said protective layer are not covered by sidewall spacers”. With regard to the rejection under 35 U.S.C. 112, second paragraph, contrary to *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953) as relied upon by the Examiner, *In re Wakefield*, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970) supports the position that limitations that exclude characteristics of the prior art are considered definite (and acceptable), if the recited limitations are definite.

Applicant respectfully submits that the above noted features whereby “edges of said protective layer are not covered by sidewall spacers” should be considered definite, at least in view of Fig. 1(h) of the present application and common knowledge as would be understood by one of ordinary skill. That is, one of ordinary skill would

readily understood that polysilicon layer 12 in Fig. 1(h) of the present application does not include sidewall spacers thereon, in contrast to gates 35 which do include sidewall spacers thereon. Applicant therefore respectfully submits that the above noted negative limitations should not be disregarded, and that claims 6-9 and 11-15 should be considered as in compliance with 35 U.S.C. 112, second paragraph. The Examiner is thus respectfully requested to withdraw this rejection for at least these reasons.

Regarding the Examiner's assertion that the above noted claim language is contradictory, the further claim language "an insulating layer, contact hole, and a connecting wire formed above a surface of the substrate" (our emphasis added), does not specify or limit the insulating layer as covering sidewalls of the protective layer. That is, the insulating layer is merely featured as formed above a surface of the substrate.

Claim Rejections-35 U.S.C. 102

Claims 6-9 and 11-19 have been rejected under 35 U.S.C. 102(b) as being anticipated by the Yoo et al. reference (U.S. Patent No. 5,605,853). This rejection is respectfully traversed for the following reasons.

As noted above, claim 6 has been amended to feature "said protective layer being a conductive layer having an edge thereof on said field oxide, whereby edges of said protective layer are not covered by sidewall spacers". The Yoo et al. reference as relied upon by the Examiner does not disclose these features.

The Examiner has interpreted floating gate 12 as illustrated in Fig. 7 of the Yoo et al. reference as the protective layer of claim 6. However, as may be readily understood in view of Fig. 7 of the Yoo et al. reference, sidewall spacers 20 are formed adjacent on floating gate 21. The Yoo et al. reference therefore does not disclose a protective layer having edges that are not covered by sidewall spacers. An improved alignment margin for contact holes to a protective layer and high quality connections as in the present invention are thus not provided in the Yoo et al. reference.

The Examiner has apparently disregarded the features of claim 6 "whereby edges of said protective layer are not covered by sidewall spacers", as negative limitations. However, as asserted above, these features should be considered as in compliance with 35 U.S.C. 112, first and second paragraphs, and thus cannot be merely disregarded. Each and every feature of the claims must be considered when determining patentability. Clearly, since floating gate 21 in Fig. 7 of the Yoo et al. reference has sidewall spacers 20 thereon, the Yoo et al. reference fails to meet the features of claim 6. Applicant therefore respectfully submits that the semiconductor device of claim 6 distinguishes over the Yoo et al. reference as relied upon by the Examiner, and that this rejection, insofar as it may pertain to claims 6-9 is improper for at least these reasons.

Independent claims 11 and 16 have been amended in a somewhat similar manner as noted above with respect to claim 6. Applicant therefore respectfully submits that this rejection, insofar as it may pertain to claims 11-19, is improper for at

least somewhat similar reasons as set forth above.

Conclusion

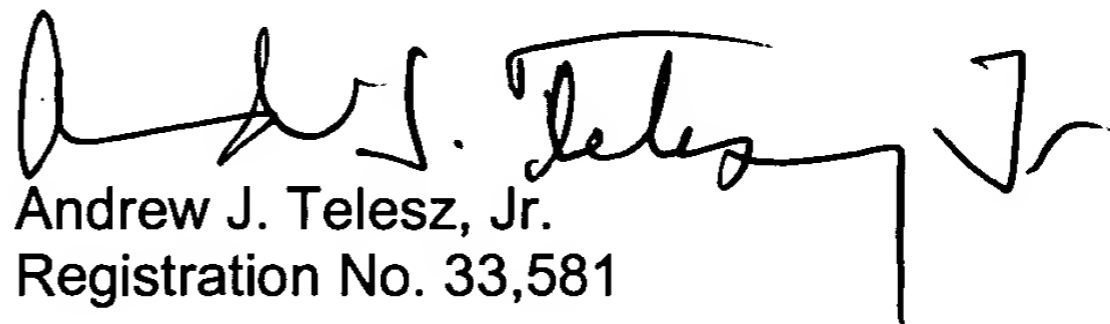
The Examiner is respectfully requested to reconsider and withdraw the corresponding rejections, and to pass the claims of the present application to issue, for at least the above reasons.

In the event that there are any outstanding matters remaining in the present application, please contact Andrew J. Telesz, Jr. (Reg. No. 33,581) at (571) 283-0720 in the Washington, D.C. area, to discuss these matters.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment for any additional fees that may be required, or credit any overpayment, to Deposit Account No. 50-0238.

Respectfully submitted,

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Enclosures: Copy of Information Disclosure Statement dated June 2, 2005
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